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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,764	01/27/2000	Richard Jove	114205.1101	1344

7590 01/28/2003

Pepper Hamilton  
600 Fourteenth Street N W  
Washington, DC 20005-2004

EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

17

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/492,764

Applicant(s)

JOVE ET AL.

Examiner

Stephen L. Rawlings, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,2 and 19-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *election facsimile cover sheet*.

### DETAILED ACTION

1. The election without traverse filed November 4, 2002 in Paper No. 15 is acknowledged and has been entered. Applicants elected the invention of group VII, claims 1-5, insofar as the claims are drawn to a method for inhibiting the growth of cancer cells in a patient, wherein said method comprises administering to said patient an antagonist of the DNA binding activity of STAT.
2. The amendment filed November 4, 2002 in Paper No. 15 is acknowledged and has been entered. Claims 3-18 have been canceled. Claim 1 has been amended. Claims 19-27 have been added.
3. Claims 1, 2, and 19-27 are pending in the application.
4. Claims 26 and 27 have been withdrawn from further consideration, as being drawn to a non-elected invention.

The examiner feels that Applicants may have mistakenly added claims 26 and 27. Despite a dependency upon claim 1, which recites a limitation requiring the antagonist to be an antagonist of STAT DNA binding, in view of the Applicants' disclosure, the limitations recited in claims 26 and 27 appear applicable to claims drawn to methods comprising administering an inhibitor of STAT dimerization or an antagonist of an SH2-pY interaction, respectively. Non-elected claims drawn to these methods were restricted to groups I and V, respectively. The specification discloses that the peptides depicted in Table 3 on page 64, which are the same peptides recited in the Markush group defining the antagonist of claim 25, are antagonists of STAT DNA binding. However, the specification does not expressly disclose that the 12- and 7-amino acid peptides of Tables 1 and 2 on pages 63 and 64, respectively, are inhibitors of STAT DNA binding; rather it appears that the specification teaches, or suggests that the 12-amino acid peptides of Table 1 might be capable of inhibiting STAT dimerization, and

the 7-amino acid peptides of Table 2 might be capable of antagonizing the interaction of a polypeptide consisting of an SH2 domain to phosphotyrosine (pY).

If Applicants were to provide factual evidence that indicates that the peptides of claims 26 and 27 are capable of inhibiting STAT DNA binding, rejoinder of the claims will be proper; however, if the peptides of claims 26 and 27 are also able to inhibit STAT dimerization and/or antagonize binding of a polypeptide consisting of an SH2 domain to pY, the restriction requirement set forth in the Office action mailed July 2, 2002 (Paper No. 13) would have to be reconsidered, since in such a case, groups I, V, and VII might have to be rejoined.

5. Claims 1, 2, and 19-25 are currently subject to further restriction.

#### ***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:  
Group I. Claims 1, 2, 19, and 20, insofar as the claims drawn to a method for inhibiting the growth of cancer cells in a patient, wherein said method comprises administering to said patient an antagonist of the DNA binding activity of STAT, wherein said antagonist is an antibody, classified in class 424, subclass 138.1.  
Groups II-XVI. Claims 1, 2, 19, and 21-25, insofar as the claims are drawn to a method for inhibiting the growth of cancer cells in a patient, wherein said method comprises administering to said patient an antagonist of the DNA binding activity of STAT, wherein said antagonist is a peptide comprising one of the amino acid sequences selected from the group of amino acid sequences consisting of those recited in claim 25, classified in class 514, subclasses 12-18.
5. The inventions are distinct, each from the other because of the following reasons:  
Inventions in groups I-XVI are disclosed as materially different methods that differ at least in objectives, method steps, reagents and/or doses and/or schedules used,

response variables, assays for end products and/or results, and criteria for success; and therefore, the claimed methods are distinct.

6. Because these inventions are distinct for the reasons given above and also because the search required for any one group is not required for any other group and/or the inventions have acquired a separate status in the art as shown by their different classification or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Art Unit: 1642

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

slr  
January 17, 2003

ANTHONY C. CASILEA  
CUSTOMER SERVICE REPRESENTATIVE  
TECHNOLOGY CENTER 1000



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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COMMENTS: \_\_\_\_\_  
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